

REMARKS/ARGUMENTS

Claims 62-64 are pending in this application. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Rejections under 35 U.S.C. §112

Claim 62 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. More specifically, the Examiner alleges claim 62 is non-statutory because it includes the USE and the METHOD OF MAKING of recycled calcium carbonate.

Applicants note that 35 U.S.C. 100(b) defines the term “process” for the U.S. Patent laws and states that: “The term ‘process’ means process, art or method, and includes a new use of a known process, machine, manufacture, composition or material, or material”. Thus a use is merely a subset of the group of statutory claims defined as process claims. According, claim 62 can be considered a process using the recycled calcium carbonate to treat a paper, board or nonwoven product.

Furthermore, to use recycled calcium carbonate for treatment of a paper, board or nonwoven product requires obtaining the recycled calcium carbonate. Accordingly, the steps for obtaining or preparing the recycled calcium carbonate to be used are properly recited as a part of the overall process for a use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product.

In view of the above amendments and remarks, the rejection of claim 62 under 35 U.S.C. §112 should be withdrawn.

Rejection of Claims under 35 U.S.C. §102

Claim 62 stands rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,759,258 (Sohara).

The Examiner states that Sohara discloses forming calcium carbonate from the residues of deinking of wastepaper process and using the formed recycled calcium carbonate for treatment of paper. However, Applicant notes that the specific step of “calcining into lime” for preparing the recycled calcium carbonate recited in claim 62 is not disclosed by Sohara.

Sohara discloses that a deink residue (DIR) is first heated and then turned to mineral ash (see col. 3, lines 35-40). The mineral ash is then used by Sohara to form the precipitated calcium carbonate (PCC) (see col. 3, lines 40-48 and 62-67; and col. 4, lines 1-9). Cols. 6-7 of Sohara, which are referred to by the Examiner in the rejection, also disclose that the DIR is incinerated to produce mineral ash, which is subsequently used for forming PCC (see e.g., col. 6, lines 37-42; and col. 7, lines 58-67).

Since Sohara discloses heating deink residue to form mineral ash, Sohara fails to disclose “calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board, or nonwoven product”, as recited in independent claim 62.

Accordingly, independent claim 62 should be allowable.

Restriction Improper Because a Use is Defined as a Method

As stated above, the U.S. patent law 35 U.S.C. §100(b) defines a process as including a new use. Thus the use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product can be considered to be a method of treating a paper, board or nonwoven product using recycled calcium carbonate. As such, the restriction of claim 63 which is directed to a method of treating a paper, board or non-woven product using recycled calcium carbonate is improper. Claim 63 is allowable for the same reasons as is independent claim 62.

Furthermore, since the steps of preparing recycled calcium carbonate are proper a part of claim 62 as indicated above, claim 64 should also be reinstated. Independent claim 64 is allowable for the same reasons as is independent claim 62.

Conclusion

In view of the above amendments and remarks, the application is now deemed to be in condition for allowance.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By /Alfred W. Froebrich/
Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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